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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,939	06/28/2007	Wilhelm Bubits	4331.75748	2365

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EXAMINER

DAVID, MICHAEL D

ART UNIT	PAPER NUMBER
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3641

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09/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,939	Applicant(s) BUBITS, WILHELM	
	Examiner MICHAEL D. DAVID	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 9/20/2007 has been considered by the examiner.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a **single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length** since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because **it appears to be about 200 words in length**. Correction is required. See MPEP § 608.01(b).

Drawings

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

The examiner objects to the drawings not being included separately, and requests that a separate set of drawings be included in the next response from applicant. The examiner has used figures 1-5 from WIPO Publication WO 2005/093361 for examining purposes.

Claim Objections

Claim 3 is objected to because of the following informalities: In line 3, it appears that the word "is" should be removed from before "located". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear to the examiner what "the former" is referring to in line 2. "The former" could be interpreted as the pistol or the grip, or both, or something else. Examiner suggests rewording this claim to make it clearer.

Regarding claim 2, it is unclear to the examiner what "the normal lines on the inclined surfaces relative to the direction of movement of the barrel" is referring to in line 2.

Regarding claim 3, it is unclear to the examiner what/which direction the applicant is referring to when reciting "towards the outside".

Claim 6 recites the limitation "said addition to the stop" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, regarding claim 6, it is generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors.

Claim 10 recites the limitation "said breech part" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Any unspecified claim is rejected as being dependent upon a rejected base claim. In light of the above, the claims will be further treated on the merits ***as best understood*** only.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

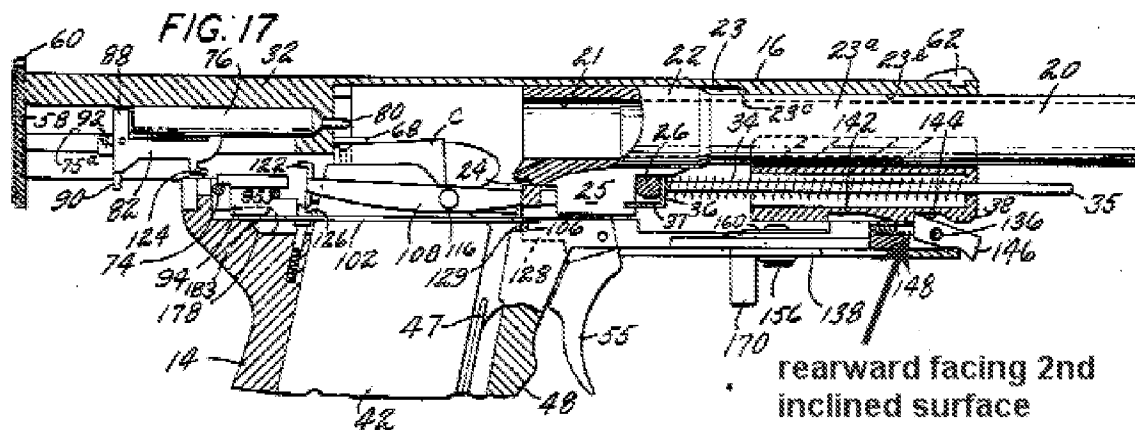
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Browning (US Patent No. 2921503).

Regarding claim 1, Browning discloses a pistol (fig. 1) comprising: a grip (fig. 1), a barrel slide (16 – fig. 1) movable in firing direction, and a barrel (20 – fig. 2,4) capable of being interlocked with the barrel slide (col. 5 lines 10-30), wherein first locking means (38 – fig. 16) are provided on the barrel, second locking means (146, 148, 54 – fig. 16, 17) are provided in the barrel slide, and unlocking means (24, 28 – fig. 14) are provided in the grip, the first locking means is a projection (38 – fig. 16) provided on the outer contour of the barrel (20 – fig. 16) and having a forward-facing first inclined surface (several forward facing inclined surfaces shown at the bottom on projection 38 – see 142, 144, and 38 in figs. 14 or 16), the second locking means is a lever (146 – fig. 16) pivotably guided (lever 146 pivots about pin 136 – fig. 16) in the barrel slide and including a dog (see fig. 17 below) having a rearward-facing, second inclined surface cooperating with the first inclined surface (see fig. 17 below), and the unlocking means is a stop (24, 28, 30 – fig. 4) provided in the grip and cooperating with a lug (25 – fig. 4) of the barrel; wherein the angle of inclination of the inclined surfaces of the lever is chosen such that when the barrel impacts against the stop and the barrel slide

continues its movement, the inclined surfaces are capable of sliding off each other, and the lever is pivoted against the force of a spring (34 – fig. 4) such that the dog releases the barrel slide (col. 16 lines 12-25, fig. 14).

Regarding the claimed invention being “*wherein the angle of inclination of the inclined surfaces of the lever is chosen such that when the barrel impacts against the stop and the barrel slide continues its movement, the inclined surfaces are capable of sliding off each other, and the lever is pivoted against the force of a spring such that the dog releases the barrel slide*” as recited in the claim, the applicant is advised that a recitation of the intended use of an invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the patented structure of Browning was considered capable of performing the cited intended use.



Regarding claim 5, Browning discloses a pistol according to claim 1, wherein said projection (38 – fig. 17) is provided on the outer contour of the barrel at the rear end thereof.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Browning (US Patent No. 2921503).

Regarding claim 2, Browning discloses the claimed invention except he does not explicitly disclose wherein said angle of inclination of the normal lines on the inclined surfaces relative to the direction of movement of the barrel is larger than the angle of friction at a friction occurring between the two inclined surfaces (although fig. 17 appears to suggest/discloses this). It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to make said angle of inclination of the normal lines on the inclined surfaces relative to the direction of movement of the barrel is larger than the angle of friction at a friction occurring between the two inclined surfaces, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 3, Browning discloses the claimed invention wherein said lever (146 – fig. 16) is a two-armed lever having its center of rotation located behind the inclined surface (fig. 14 shows 146 located behind inclined surface 144 or 38), whose forward directed arm carries a dog (146 – fig. 16), and whose rearward directed arm presses a spring (spring 34 is pressed via projection 38 – fig. 16) except he does not explicitly disclose the spring being pressed “towards the outside”. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the spring being pressed "towards the outside", since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

Regarding claim 4, Browning discloses the claimed invention except for wherein said spring is a leaf spring although he does disclose the use of a leaf spring (160 – fig. 20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a leaf spring, since the equivalence of a spring and leaf spring for their use in the firearm art and the selection of any known equivalents to act

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as an elastic or energy storing component would be within the level of ordinary skill in the art.

Regarding claim 6, Browning discloses the claimed invention except for a second/further stop. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a second/further stop, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St, Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 7, Browning discloses the claimed invention except for wherein the further stop is retractable (although he does disclose that it is known in the art to have retractors – col. 1 lines 62-66) . It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the stop retractable, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

Regarding claim 8, Browning discloses the claimed invention except for two lateral projections one on either side. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two lateral projections, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St, Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 9, Browning discloses the claimed invention except for wherein said levers are located in lateral through holes of the barrel slide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

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have levers located in lateral through holes of the barrel slide, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

Regarding claim 10, Browning disclose many breech parts fastened in the barrel slide (fig. 4), and an ejector claw being arranged on the upper front edge of a breech part (claw/extractor 66 - col. 9 lines 9-20).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record discloses various locking/slide mechanisms in firearms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. David whose telephone number is 571-270-3737 and whose email address is michael.david@uspto.gov. The examiner can normally be reached on Monday-Friday, 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MDD/
9/9/2009

/Bret Hayes/
Primary Examiner, Art Unit 3641